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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
GOFF II, JOHN L	

ART UNIT	PAPER NUMBER
1733	

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/810,794	ROMIG ET AL.	
	Examiner	Art Unit	
	John L. Goff	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 August 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 23-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 23-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the amendment filed on 8/30/04.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 36 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 36 requires a "pharmaceutical bottle having a generally rigid overall external contour". Applicants specification does not disclose using a pharmaceutical bottle having a generally rigid overall external contour. It is suggested to delete the language from the claim to overcome the rejection.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 36 requires a "pharmaceutical bottle having a generally rigid overall external contour". It is unclear what is required by "generally rigid", and there is no disclosure within applicants specification. Thus, generally rigid has been interpreted to require usually (i.e. generally) rigid, or in other words all that is required is a shape-retaining bottle.

Claim Rejections - 35 USC § 103

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 2, 6, 23, 25-27, and 30-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hart (GB 2205295) in view of James (U.S. Patent 3,360,412) and either one of Rutledge (U.S. Patent 3,245,857) or Kaercher et al. (U.S. Patent 3,905,854).

Hart discloses a technique of labeling the external surface of a semi-permeable, pre-formed, shape-retaining plastic container, e.g. a bottle, with a label having a metal base (or other gas impermeable material) such that the label reduces or prevents the permeation of gases

through that part of the surface of the container covered by the label, i.e. the metal base acts as a barrier to prevent passage therethrough of contaminants into or out of the container. Hart teaches the label may further comprise at least one other layer such as an outer printed layer (i.e. the printed layer is attached/coupled to the metal base). Hart teaches the label may cover at least 50% of the external surface area of the container, i.e. the label covers an area of the external surface less than the external surface area so that a remainder of the external surface area is exposed. Hart further teaches attaching the label to the external surface of the container in **"any suitable manner"** (Page 1, 10-13 and Page 2, lines 29-35, and Page 3, lines 1-6, 11-12, 15-23, and 28-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the metal base of the label taught by Hart to the plastic container in any suitable manner such as by dry lamination, i.e. a technique wherein the metal base is heated such that the heat of the metal base melts the outside surface of the container and fuses (after cooling) the metal base to the container, as it was well known and conventional in the art to attach a substrate layer, e.g. metal, to a polymeric layer by dry lamination as shown for example by James such that lamination occurs without the use of an intermediate bonding agent, it being further obvious to one of ordinary skill in the art at the time the invention was made to perform the lamination of Hart using dry lamination as shown for example by James as dry laminating techniques were already in use for laminating metal containers to labels having a polymeric base as shown for example by either one of Rutledge or Kaercher et al.

Regarding claims 25, 26, 31, 32, and 35, Hart as modified by James and either one of Rutledge or Kaercher et al. are silent as to the melting/fusing temperature, it being noted the only requirement is that the temperature applied is sufficient to melt the outside surface of the

container. Absent any unexpected results, it would have been obvious to one of ordinary skill in the art at the time the invention was made to experimentally determine/optimize the melting/fusing temperature applied as a function of the material of the plastic container such that during melting/fusing the plastic container is not burned or deformed as doing so would have required nothing more than ordinary skill and routine experimentation.

Regarding claim 34, it is noted the metal base layer of the label taught by Hart is intrinsically capable of preventing contaminants (such as adhesive or ink) on the external surface of the metal label from contacting the external surface of the plastic bottle.

James discloses "dry lamination" for laminating a polymer layer to a dissimilar substrate layer, e.g. metal, without the use of a intermediate bonding agent wherein the technique is useful in for example packaging. James teaches the method comprises heating the substrate layer and then contacting the heated substrate layer with the polymer layer, the substrate layer heated to at least the melting/fusing temperature of the polymer layer, such that the polymer layer melts and is fused with the substrate layer (after cooling) (Column 1, lines 38-43 and Column 2, lines 68-72 and Column 3, lines 1-6, 9-12, and 49-60 and Column 4, lines 46-49 and Column 5, lines 53-64). Both Rutledge and Kaercher et al. disclose bonding a metal container to a label having a polymer base by heating the metal container to the melting/fusing temperature of the polymer base and then contacting the heated metal container with the polymer base of the label such that the polymer base melts and is fused with the metal container (after cooling) (Column 4, lines 20-45 and Column 5, lines 39-47 and 61 and Column 6, lines 1-4 of Rutledge and Column 6, lines 22-26 and Column 7, lines 3-9 of Kaercher et al.).

10. Claims 3-5 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hart and James and either one of Rutledge or Kaercher et al. as applied to claims 1, 2, 6, 23, 25-27, and 30-35 above, and further in view of the admitted prior art (Specification pages 1 and 2).

Hart as modified by James and either one of Rutledge or Kaercher et al. teach all of the limitations in claims 3-5 and 36 as applied above except for a specific teaching of all the different types of containers that may be labeled, it being noted the container taught by Hart as modified by James and either one of Rutledge or Kaercher et al. has substantially the same structure, i.e. a shape-retaining container, as the containers disclosed in claims 3-5 and 36 such that the claims appear mainly directed to intended use. In any event, Hart as modified by James and either one of Rutledge or Kaercher et al. suggest a label and method for labeling a shape-retaining plastic container, and they are not limited to any particular type of container. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the label and method taught by Hart as modified James and either one of Rutledge or Kaercher et al. to label any well known and conventional container such as pharmaceutical bottles (shape-retaining plastic bottles), IV bags and food packages (plastic bags), etc. as it was known in the art to label these types of containers as shown for example by the admitted prior art and only the expected results would be achieved.

The admitted prior art is directed to labeling containers wherein the containers include plastic bottles, pharmaceutical bottles, IV bags, food packages, etc. (Specification pages1 and 2).

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hart and James and either one of Rutledge or Kaercher et al. as applied to claims 1, 2, 6, 23, 25-27, and 30-35 above, and further in view of Kelch et al. (U.S. Patent 6,042,930).

Hart and James and either one of Rutledge or Kaercher et al. teach all of the limitations in claim 7 as applied above except for a specific teaching of using a base layer of metallized polyester. However, it is noted Hart is not limited to any particular base layer only that the base layer is formed of a gas impermeable material. It would have been obvious to one of ordinary skill in the art at the time the invention was made would to use as the base layer taught by Hart as modified by James and either one of Rutledge or Kaercher et al. any well known and conventional gas impermeable material used in labels such as metallized polyester, i.e. Mylar, as shown for example by Kelch et al. as only the expected results would be achieved, i.e. the metallized polyester base would give the label gas impermeable properties.

Kelch et al. are directed to heat-activated adhesive labels for use in labeling containers. Kelch et al. teach the base layer of labels may comprise oriented polyester such as Mylar (Column 2, lines 12-19 and 34-36 and Column 8, lines 21-22).

12. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hart and James and either one of Rutledge or Kaercher et al. as applied to claims 1, 2, 6, 23, 25-27, and 30-35 above, and further in view of Yoda et al. (U.S. Patent 3,961,009).

Hart and James and either one of Rutledge or Kaercher et al. teach all of the limitations in claim 24 as applied above except for a specific teaching of actively cooling the labeled container in a cooling bath, it being noted the labeled articles taught by Hart and James and either one of Rutledge or Kaercher et al. are at least intrinsically cooled by cooling/ambient air. It would have

been well within the purview of one of ordinary skill in the art at the time the invention was made to cool the labeled container taught by Hart as modified by James and either one of Rutledge or Kaercher et al. in a cooling bath or cooling air as both were well known and conventional alternatives in the art for cooling as shown for example by Yoda et al. and only the expected results would be achieved, i.e. cooling in a bath is faster but more labor intensive/expensive.

Yoda et al. are directed to extrusion shaping polymers to form heat resistant articles. Yoda et al. teach cooling the extruded articles using cooled air or a cooling bath (Column 6, lines 19-21).

13. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hart and James and either one of Rutledge or Kaercher et al. as applied to claims 1, 2, 6, 23, 25-27, and 30-35 above, and further in view of Swierczek (U.S. Patent 5,024,014).

Hart and James and either one of Rutledge or Kaercher et al. teach all of the limitations in claims 28 and 29 as applied above except for a specific teaching of using a printed layer wherein a bonding agent is required to bond the printed layer to the base layer. One of ordinary skill in the art at the time the invention was made would have readily appreciated incorporating into Hart as modified by James and either one of Rutledge or Kaercher et al. a printed layer bonded to the base layer through a bonding agent to apply articles such as attached coasters to the container as suggested by Swierczek.

Swierczek is directed to label for use as a coaster. Swierczek teaches a label comprising an inner adhesive layer and an outer print layer. Swierczek teaches the label can be attached directly to the external surface of a container or the label can be placed over a conventional label

on the container (Figures 1-6 and Column 2, lines 4-8, 14-16, and 50-54 and Column 3, lines 33-35).

Response to Arguments

14. Applicant's arguments with respect to claims 1-7 and 24-36 have been considered but are moot in view of the new ground(s) of rejection. Applicants argue there is no mention of James, Rutledge, or Kaercher et al. in Hart, and there is no suggestion to combine the references. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hart discloses bonding a label having a metal base to a plastic container **using any suitable method**. James discloses that within the packaging art dry lamination was a known suitable method for attaching a metal layer to a plastic layer, thus avoiding the use of an intermediate bonding agent. Rutledge and Kaercher et al. disclose that within the container labeling art dry lamination was a known technique for attaching labels having a plastic base to a metal container. Thus, clearly in view of the above it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the metal-plastic bonding taught by James using a suitable technique such as dry lamination as was known within the same art as shown for example by James and Rutledge or Kaercher et al. to perform the bonding without requiring the use of an intermediate bonding agent.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571) 272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John L. Goff

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